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SEPT 10, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Timothy J. Sheehan**

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Serial No. 74/**490,595**

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**Merrily Porter** of the Law Offices of James O. Houchins for  
Timothy J. Sheehan.

**David Reihner**, Trademark Examining Attorney, Law Office 107  
(Thomas Lamone, Managing Attorney).

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Before Cissel, Seeherman and Walters, Administrative  
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

Applicant filed the above-referenced application on  
February 16, 1994 to register the mark "CUBITA" on the  
Principal Register for "coffee," in Class 30. The basis  
for the application was applicant's assertion that he had  
used the mark on these goods in commerce since March 1,  
1994.

This application now comes up before the Board on appeal from a final refusal to register under Section 2(e)(3) of the Lanham Act on the ground that "CUBITA" is primarily geographically deceptively misdescriptive of the goods on which applicant uses it. Applicant did not request an oral hearing before the Board, but both applicant and the Examining Attorney filed briefs.

The record includes a copy of an entry in a Spanish dictionary which shows that "ita" is one of "the most common diminutive endings" in the Spanish language; copies of entries from two encyclopedias, an almanac and a geographical dictionary showing that Cuba is a well-known geographic place name for the island country in the West Indies, ninety miles south of Florida, and that one of its chief products is coffee; a copy of a dictionary entry defining the adjective "diminutive" as "designating certain suffixes that denote smallness, youth, familiarity, or affection."

Also of record are copies of excerpts from the United States Code of Federal Regulations which provide details about the United States' embargo of products from Cuba since 1963.

The specimens of use submitted with the application, of course, are also part of the record in this appeal.

They are labels affixed to containers, which are apparently bags, for applicant's coffee. The front of the label shows the mark above the words "WHOLE BEAN." Beneath these words is an illustration wherein coffee beans are arranged in the shape of a map of Cuba inside an oval design. Spanish and English versions of "Dark Roast" and "Medium Roast" are printed next to boxes which are to be marked according to the contents of particular bags. Beneath these two choices are the words "EL SABOR DE CUBA," which translate into "THE FLAVOR OF CUBA." The rear portion of the label notes that the contents of the bag are the product of Equador, roasted and imported by a business in Texas. Under twin headings of "Cubita," Spanish and English versions of the following are printed:

This coffee is picked from the finest Equadorian beans. Traditional processing gives this coffee a taste and aroma suitable for the most discerning Cuban palate.

The column in English goes on to state that each bag contains reproductions of works of art by famous Cuban artists and accounts of famous Cubans.

The well-settled rule for determining whether registration should be refused under Section 2(e)(3) of the Act has several steps. First, we must determine if the primary significance of the term is the name of a

geographic place which is neither obscure nor remote. If so, in order for a refusal to be proper, the next question which must be answered in the affirmative is whether there is a goods/place association, that is, whether prospective purchasers would expect or understand that goods of the type specified in the application come from the place named. The last part of the test is to determine whether or not the goods do in fact come from the place named. If they do not, the term is properly refused registration under Section 2(e)(3) because it is primarily geographically deceptively misdescriptive of the goods. In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982); In re California Pizza Kitchen, Inc., 10 USPQ2d 1704 (TTAB 1988).

After careful consideration of these legal principles in light of the record in this application and the arguments of both applicant and the Examining Attorney, we hold that registration of this mark is not barred by Section 2(e)(3) of the Act because the first part of the test is not satisfied. This record does not establish that "CUBITA" would be understood by coffee purchasers as the name of a place.

The critical issue in this case is whether the primary significance of "CUBITA" to coffee buyers in the United

States is as the name of a geographic place, i.e., another name for "CUBA," or whether, as applicant asserts, the addition of the diminutive suffix "ITA" to the root form of the name "CUBA" alters its significance to the extent that its primary significance is no longer that of the place name.

The dictionary definition of record mentioned above explains that the addition of a diminutive suffix to a word may denote smallness, youth, familiarity or affection. As applied to the root form of "CUBA," the suffix "ITA" would not reasonably connote youth or smallness, but rather, the resulting term, "CUBITA," would be understood as a familiar or affectionate reference to the country. As applicant argues, the mark, like the text on the label quoted at length above, would be understood as creating the suggestion that applicant's coffee possesses the flavor, style or aura associated with Cuban coffee. In the same sense that "Tommy" and "Jonesy" would be understood to be familiar, affectionate terms for people named "Thomas" and "Jones," the mark "CUBITA" would be recognized as an affectionate reference to Cuba, but just as "Jonesy" is not a surname, "CUBITA" is not the name of a place. In fact, the record does not show that this term has ever been used by anyone, including applicant, as another name for Cuba.

For that matter, the record does not reveal that in common parlance the diminutive suffix "ITA" is ever appended to place names, either in order to refer to them in a familiar or affectionate way, or to suggest their smallness or youth. Based on this record, it appears that applicant has taken the diminutive suffix "ita," which is usually combined with ordinary nouns like "casa" (house) and "flor" (flower), and combined it with the name of the country, "Cuba," in order to create an unusual resulting term for his trademark. Under these circumstances, the resulting trademark, "CUBITA," would not immediately be understood as the name of the place.

In summary, the first part of the test for refusing registration under Section 2(e)(3) has not been met in this case. The term sought to be registered does not have as its primary significance the name of a place. Accordingly, the refusal to register is reversed.

R. F. Cissel

E. J. Seeherman

C. E. Walters

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Administrative Trademark Judges  
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